



HEWLETT-PACKARD COMPANY
INTELLECTUAL PROPERTY ADMINISTRATION
PO BOX 272400
FORT COLLINS, CO 80528-9599

In re Application of
Beatty et al.
Application No. 10/059,942
Deposited: January 28, 2002
Attorney Docket Number: 10970794

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: DECISION GRANTING-IN-PART
: PETITION
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In re Application of
Beatty et al.
Application No. 10/060,035
Filed: January 31, 2002
Attorney Docket Number: 10970794

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: DECISION MERGING FILES
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According to the PTO records, Application Nos. 10/059,942 and 10/060,035 are both continuation applications of Application No. 09/378,230. The petition requests that Application No. 10/059,942 be accorded a filing date of January 28, 2002, and that the 2 application files be merged.

Background

Applicants deposited on January 28, 2002¹ a "Request for a Continuing Application under 37 CFR 1.53(b)" ("1/28/02 Request") along with a copy of the "Declaration and Power of Attorney for Patent Application" from the parent application, and a Preliminary Amendment which contains at least 1 claim but not other components required for receiving a filing date.² In response to a March 6, 2002 Notice of Incomplete Nonprovisional Application mailed by the Office of Initial Patent Examination (OIPE), a copy of the parent application (specification including claims; drawings) was submitted on March 25, 2002. Accordingly, this application, assigned No. 10/059,942, was accorded that filing date.

Application No. 10/060,035, upon receipt in the PTO on January 31, 2002, included, *inter alia*, a copy of the parent application (specification including claims; drawings). The PTO relied on the "Express Mail" Certificate of Mailing contained in the transmittal letter and accorded that application a January 28, 2002 filing date.

The petition asserts that the papers assigned No. 10/060,035 were actually intended for supplementing the 1/28/02 Request in order to complete the continuation application.

¹ As confirmed from www.usps.gov, the 1/28/02 Request, bearing a U.S. Express Mail mailing label number ET 616070751 US, was deposited on 1/28/02.

² Namely, a specification as prescribed by 35 U.S.C. 112 that meets the enablement and best mode requirements. Drawings are not required for filing date purposes here because the Preliminary Amendment contains at least 1 method claim. See MPEP 601.01(f) (Aug. 2001).

Application No. 10/060,035

As explained below, **Application No. 10/060,035 was not properly filed in accordance with 37 CFR 1.10 even though it was complete for purposes of filing date when received in the PTO on January 31, 2002.**

Under 37 CFR 1.6(a), correspondence received in the PTO is stamped with the date of receipt. Certain exceptions exist, one being that correspondence filed in accordance with §1.10 will be considered filed on the date of deposit as “Express Mail” in the USPS. Should there be a discrepancy between the USPS date of deposit and an accorded filing date, one may petition for a filing date as of the §1.10 date of deposit by showing that the number of the “Express Mail” mailing label was placed on the paper(s) that constitute the correspondence prior to the mailing by “Express Mail.”³

According to the Office records, Application No. 10/060,035 was deposited as “Express Mail” in the USPS on January 28, 2002 under mailing label number **ET209954844US**. Unfortunately, the transmittal letter includes a “Certificate of Mailing by ‘Express Mail’ under 37 CFR 1.10” that bears a different mailing label number, **ET616070751US**. Therefore, this certificate of mailing is ineffective, in that, Application No. 10/060,035 was deposited **without the true mailing label number** and, consequently, is only entitled to a filing date of January 31, 2002, the day it was received in the PTO.⁴

Application No. 10/059,942

The 2 continuing applications contain identical attorney docket number, inventors, and title of the invention.⁵ Moreover, the transmittal letter for the papers assigned No. 10/060,035 is entitled “Transmittal of Prior Application for Continuation Application Filed Today” and unequivocally states that these papers were inadvertently not included with those filed earlier on the same day. The Office thus concludes that the papers assigned No. 10/060,035 were misconstrued by OIPE as a new application. These papers have been transferred to the file of Application No. 10/059,942 where they properly belong.

In summary, the petition is **granted-in-part**, in that, while the 2 files have been merged as

³ See 37 CFR 1.10(c); MPEP section 513 (Aug. 2001).

⁴ See MPEP section 513 (Aug. 2001) “EXPRESS MAIL” MAILING LABEL NUMBER, quoting Nitto Chemical Industry Co., Ltd. V. Comer, 39 U.S.P.Q.2d 1778, 1782 (D.D.C. 1994) (Commissioner’s refusal to waive requirements of 37 CFR 1.10 [under 37 CFR 1.183] in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 CFR 1.10 is an “avoidable” oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 CFR 1.183.).

⁵ A Supplemental Preliminary Amendment to Application No. 10/059,942, filed on 3/25/02, changed the invention title.

requested, Application No. 10/059,942 as it existed upon filing⁶ is not accorded the requested filing date of January 28, 2002; rather, the application papers (present on filing) in conjunction with those of Application No. 10/060,035 are hereby accorded a filing date of January 31, 2002.⁷


The \$130 petition fee will not be refunded as requested because the incomplete filing which resulted in the initial filing date of March 25, 2002 was not necessitated by any error of the PTO.⁸

Finally, the practitioner signing the instant petition uses a correspondence address different from that in the Office records, and does not appear to have a power of attorney from the assignee. While a courtesy copy of this decision is being sent to this practitioner, all future correspondence concerning this application will be mailed to the address-of-record unless the PTO is properly instructed otherwise.

The file of application No. 10/060,035 is being forwarded to OIPE for removing that application from the roster of active application numbers. The April 8, 2002 Notice to File Missing Parts of Nonprovisional Application, concerning missing oath or declaration, is hereby vacated since one was submitted with the papers assigned No. 10/059,942 on January 28, 2002.

The file for application No. 10/059,942 is being returned to OIPE for further processing with a filing date of January 31, 2002, for issuance of a corrected Filing Receipt, for indication in PTO records that 4 sheets of drawings were present on filing, and for establishing continuity with application No. 09/378,230. Thereafter, the application will be forwarded to Technology Center 1700 for examination in due course.

Telephone inquiries should be directed to Petitions Attorney RC Tang at (703) 308-0763.


Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Steven J. Adamson, PC
PO BOX 5997
Portland, OR 97228

⁶ I.e., the 1/28/02 Request; the copy of the Declaration and Power of Attorney for Patent Application from the parent application; and the Preliminary Amendment.

⁷ The 3/25/02 Supplemental Preliminary Amendment filed in Application No. 10/059,942 is not in Application No. 10/060,035, and retains the 3/25/02 submission date.

⁸ The \$740 basic filing fee and the \$84 extra claims fees for application No. 10/060,035, previously charged to this deposit account, were credited to the same account on 8/28/02.